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09/574,950

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Dale F McIntyre

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12/21/2005

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EXAMINER

VU, NGOC K

ART UNIT

PAPER NUMBER

2611

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/574,950 | MCINTYRE ET AL. | |
| | Examiner | Art Unit | |
| | Ngoc K. Vu | 2611 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/5/2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "said remote service" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 5, 6, 8-11 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (US 5,666,215 A) in view of Manowitz et al. (US 6,614,470 B1).

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Regarding claim 1, Fredlund discloses a method for requesting photographic services on images (see abstract), the method comprising the steps of:

capturing images in an image capture device 10 (figure 7A);

a cable TV communication unit 44 being operationally associated with a monitor 48 (see figure 1A), said cable TV communication unit 44 being capable of communicating with a remote service provider 134 over a broadband communication network 40 (see figures 7A-7C);

selecting at least one image from said captured images viewed on the monitor 48 and at least one photographic service which is to be performed on said at least one image (a program displays a graphical user interface 50 on the display device 48 that enables the customer to select one of the images for the desired photographic service – see col. 5, lines 14-31, lines 35-37); and

sending said at least one image to a service provider 138 over said broadband communication network for fulfillment of said at least one photographic service (see col. 8, lines 51-56 and figures 7A-7C).

Fredlund does not specifically disclose accessing the cable TV communication unit with said image capture device and forwarding the captured images to the cable TV communication unit for viewing. However, Manowitz shows that digital image input devices 106 & 110 connect to a set top box device 104 to provide the images for viewing on television (see figure 1 and col. 2, lines 32-36 and 59-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Fredlund by providing the captured images from a digital image input device to a set top box for displaying the captured images on television as taught by Manowitz in order display immediately the captured images on television in a more convenient manner.

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Regarding claim 2, Fredlund discloses that the cable communication unit 44 is a set top box operationally associated with a television (see col. 4, lines 38-45).

Regarding claim 3, Fredlund discloses the cable TV communication unit 44 is a set top box connected to a television set (see col. 4, lines 40-41). Fredlund does not explicitly disclose the set top box 44 is digital set top box. Official Notice is taken that digital set top box type is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cable TV communication unit 44 of Fredlund by including a digital set top box to provide high quality images for viewing.

Regarding claim 5, Fredlund discloses the server network comprises cable TV network 40, computer 26 and a network image server 136 (see col. 8, lines 45-56 and col. 4, lines 43-45 and figures 7A-C).

Regarding claim 6, Fredlund disclosed that the computer 26 stores a low resolution version of the image and the server 136 stores a high resolution version of the image (see col. 8, lines 45-51).

Regarding claim 8, Fredlund discloses that at least one image is routed to said photographic service provider 104 which performs said selected photographic service on said associated image (see figure 7C and col. 8, lines 55-61).

Regarding claim 9, Fredlund further discloses that the selected photographic service comprises selecting a desired size and quantity of prints of said at least one image and returning said prints to a designated customer (see Fredlund: col. 5, lines 35-38; col. 8, lines 16-24).

Regarding claims 10-11, Fredlund further discloses that the selected photographic service comprises a desired image product which is to be associated with said at least image

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and returning said image product such as a mug and T-shirt to a designated customer (see Fredlund: col. 5, lines 44-51).

Regarding claim 16, Fredlund as modified by Manowitz discloses that the digital image input device 106/110 is a digital camera (see Manowitz: col. 2, lines 59-67).

Regarding claim 17, Fredlund and Manowitz do disclose the image input device is a hybrid digital/film camera. Official Notice is taken that hybrid digital/film camera type is well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined system of Fredlund and Manowitz by including a hybrid digital/film camera to capture images without and/or with film.

Regarding claim 18, Fredlund discloses a method of obtaining image services (see abstract), the method comprising the steps of:

accessing a cable TV communication unit 44, said the cable TV communication unit 44 being operationally associated with a monitor 48 and a cable TV communication network 40 (see figures 7A-7C; col. 4, lines 37-45);

receiving images on said cable TV communication unit 44 for viewing on the monitor 48 (see col. 8, lines 24-27 and 38-42); and

selecting at least one image from said images viewed on the monitor 48 and requesting an order for at least one photographic service which is to be performed with respect to said at least one image using said cable TV communication unit (a program displays a graphical user interface 50 on the display device 48 that enables the customer to select one of the images for the desired photographic service and request an order the selected images using link 40 – see col. 8, lines 51-56; col. 5, lines 14-31 and lines 35-45); and

sending said at least one image to service provider 138 over broadband communication network 40 for fulfillment of said at least one photographic service (see col. 8, lines 51-56 and figures 7A-7C).

Fredlund does not teach forwarding the captured images to the cable TV communication unit for viewing. However, Manowitz shows that digital image input devices 106 & 110 connect to a set top box device 104 to provide the images for viewing on television (see figure 1 and col. 2, lines 32-36 and 59-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Fredlund by providing the captured images from a digital image input device to a set top box for displaying the captured images on television as taught by Manowitz in order display immediately the captured images on television in a more convenient manner.

Regarding claim 19, Fredlund discloses sending order to a remote service provider 134 for fulfillment over said broadband communication network (see col. 4, lines 43-45; col. 8, lines 51-56).

6. Claims 7 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al (US 5,666,215 A) in view of Manowitz et al. (US 6,614,470 B1) and further in view of Shiota et al. (US 6,324,521 B1).

Regarding claim 7, Fredlund does not explicitly disclose a cable server routing the image to a network image server via an Internet network. However, Shiota discloses that a center server 12 stores low resolution image data. If the processing requires the special equipment, the center server 12 sends an instruction information included digital image data to a laboratory server 8 in a special laboratory 4 via Internet (see figure 1 and col. 7, lines 51-55; col. 8, line 57 to col. 9, line 5; col. 9, lines 60-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Fredlund by

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routing the image from a center server to a special laboratory via Internet as disclosed by Shiota to provide the photograph service to the customers widely.

Regarding claim **12**, the combination teaching of Fredlund and Manowitz as modified by Shiota further discloses forwarding at least one image via a server network 2 to a friend (see Shiota: col. 11, lines 56-61; col. 12, lines 18-22 and figure 7).

Regarding claim **13**, the combination teaching of Fredlund and Manowitz as modified by Shiota further discloses that the friend receives the image through a further cable communication network (see Shiota: col. 2, lines 56-61 and figure 7).

Regarding claim **14**, the combination teaching of Fredlund and Manowitz as modified by Shiota further discloses that the friend receives the image through a PC 6 (see figure 7).

Regarding claim **15**, Frednlund as modified by Shiota discloses further step of entering further photographic service requests for the image from the friend (see Shiota: figure 7; col. 11, lines 50-53).

Response to Arguments

7. Applicant's arguments filed 10/5/05 have been fully considered but they are not persuasive.

First, applicant argues "There is no teaching or suggestion in Fredlund of transmitting images from an image capture device to a cable TV communication unit and then forwarding from the unit to the service provider as taught and claimed." This argument is not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., forwarding of the image from the cable TV communication unit to a service provider over a broadband

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communication network – see Remarks: 2nd paragraph on page 7) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, applicant argues that the Manowitz reference does not teach or suggest that the device is connected to a service provider such as a cable TV service provider to forwarding of images (see Remarks: 2nd paragraph on page 8). This argument is not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Moreover, with respect to claim, the features of a cable TV communication unit (i.e., set top box 44) communicating with a remote service provider (134) over a broadband communication network (40) is taught by Fredlund (see Fredlund – figures 7A-7C; col. 4, lines 40-45). Fredlund further teaches sending image(s) to a service provider (digital image center 134) over the broadband communication network (40) for fulfillment of photographic service. For example, a customer is able to select images and services and order the desired number and size of prints and other image related services for the selected images. After the order is prepared, the customer communicates the order to the digital image center 134 over communication network 40 (see figures 3-5 and 7A-7C; col. 8, lines 51-56).

Third, applicant further argues that there is no motivation or suggestion of combining the Fredlund and Manowitz references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or

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modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation or suggestion of feature of providing the captured images from a camera to a television for immediately display in a more convenient manner is found in the Manowitz reference (see col. 1, lines 48+).

Finally, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., uploading of images from a TV set top box to a remote service provider using a broadband communication network – see last paragraph on page 8) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ngoc K. Vu
Primary Examiner
Art Unit 2611

December 13, 2005